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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,557	01/08/2002	Teng-Kuei Yang	12725 B	1318

7590 05/28/2003

Hart, Baxley, Daniels & Holton  
Fifth Floor  
59 John Street  
New York, NY 10038

EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/039,557

Applicant(s)

YANG ET AL.

Examiner

Andrea D Small

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) parts of 1 and claims 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 2,5 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 5
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *I. Applicant's Response:*

- (a) Applicants response filed 5/2/2003 has been received and entered as paper no. 3.
- (b) Claims 1-19 are pending.

### *II. Restriction/Election:*

- (a) Applicants have elected to prosecute the invention of group I, claims 1-9 and have elected the species of formula I-1 on page 4.
- (b) Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
- (c) Claims 10-19 are with drawn as being drawn to non-elected inventions. 37 CFR 1.142(b).
- (d) Generic Concept:

The generic concept that is being examined is as follows:

Compound of formula I in claim 1, wherein

R1 is aryl or alkyl of C1-C9;

R2 is aryl or alkyl of C1-C9;

R3 is alkyl of C1-C9;

R4 is alkyl of C1-C9; or

R3, R4 and N can form a three-to-eight membered heterocycle; and

R5 can be H or alkyl of C1-C6.

- (e) The remaining subject matter of claim 1 is withdrawn from consideration as being drawn to non-elected inventions. 37 CFR 1.142(b).

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**II. Rejections:**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "suitable ligands" in claim 1 is a relative term, which renders the claim indefinite. The term "suitable ligands" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Amending said claim to limit the substituents to the group identified supra would overcome said rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3-4 and 6-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Hsu, et al.

Applicants claims relate to compounds of formula I in claim 1. The Hsu, et al reference discloses compounds that fall within the scope of claim 1.

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(a) Claims 1, 3-4 and 8 are anticipated by example 27, 28 and 29 on page 8580 of reference.

Wherein R3 and R4 together with the N form a six membered heterocycle or R3 and R4 are each independently alkyl; R1 is alkyl; R2 is aryl and R5 is hydrogen.

(b) Claims 6 and 7 are anticipated by example 28 and 29 on page 8580 of reference, wherein R3 and R4 are each independently alkyl; R1 is alkyl; R2 is aryl and R5 is hydrogen.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kossenjans, et al.

Claims 1, 3-4 and 6-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Hsu, et al.

Applicants claims relate to compounds of formula I in claim 1. The Hsu, et al reference discloses compounds that fall within the scope of claim 1.

(a) Claims 1, 3-4 and 8 are anticipated by example 26b of reference, wherein R3 and R4 together with the N atom form an eight membered heterocycle; R1 is alkyl; R2 is aryl and R5 is hydrogen.

***III. Objections:***

(a) Claims 2, 5 and 9 are objected as being dependent on a rejected base claim and would appear allowable if rewritten in independent form.

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(b) Claims 1 and 10-19 are objected to as containing non-elected subject matter. 37 CFR 1.142(b).

**IV. Contacts:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.  
May 22, 2003

  
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Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626  
Technology Center 1